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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Harvey A. Furman

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KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

EXAMINER

FEELY, MICHAEL J

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/643,289

Applicant(s)

FURMAN ET AL.

Examiner

Michael J. Feely

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 9-13 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Pending Claims

Claims 1, 3, 4, and 6-13 are pending.

Response to Arguments

1. Applicant's arguments filed August 10, 2007, with respect to Principato (US Pat. No. 5,340,493) have been fully considered but they are not persuasive. Applicant argues that Principato does not anticipate the instant claims because he discloses the uses of a surfactant (and the instant claims do not include a surfactant). It should be noted that the instant claims feature the transitional language *comprising*. Hence, the scope of the claims is open to additional materials, such as a surfactant. Furthermore, instant claim 10 explicitly calls for the use of a surfactant. Contrary to Applicants' position, Principato does indeed anticipate the claims. The rejection of claims 1, 3, 4 and 9-12 under 35 U.S.C. 102(b) as being anticipated by Principato (5340493) *stands for the reasons of record*.
2. Applicant's arguments with respect to Mulcahy et al. (US Pat. No. 5,340,495) have been considered but are moot in view of new ground(s) of rejection.

Claim Interpretation

3. In claims 1, 3, 4, and 6-13, the recitation "*for removing and preventing build-up of paraffin, tars, heavy oil, calcium carbonate, iron oxide and other soils and scales, from gas or oil wells, hydrocarbon bearing formations, or recovery, pumping, storage, or transmission equipment,*" has been given little patentable weight because the recitation occurs in the

Art Unit: 1796

preamble. A preamble is generally not accorded patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In the instant case, the preamble merely recites the intended use of the composition, wherein the prior art can meet this future limitation by merely being capable of such intended use.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 3, 4, and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Principato (US Pat. No. 5,340,493).

Regarding claims 1, 3, 4, and 9-12, Principato discloses: **(1)** a composition comprising: about 40 to 99 wt% of a fatty acid alkyl ester blend (Abstract; column 4, lines 10-24; column 5, lines 9-15) and about 1 to 20 wt% of at least one lower alkyl glycol ether selected from methyl, ethyl, propyl or butyl ethers of ethylene glycol, diethylene glycol, dipropylene glycol or tripropylene glycol and mixtures thereof (Abstract; column 4, lines 10-24; column 5, line 16-35, *particularly column 5, lines 29-30*); wherein the fatty acid alkyl ester blend contains C₁-C₄ esters of C₄-C₂₂ fatty acids (column 5, lines 9-15);

Art Unit: 1796

(3) wherein the fatty acid alkyl ester blend contains esters selected from the group consisting of methyl, ethyl, n-propyl, isopropyl, and n-butyl esters of C₄ to C₂₂ fatty acids (column 5, lines 9-15); (4) wherein the fatty acid alkyl ester blend contains esters selected from the group consisting of the methyl esters of C₄ to C₂₂ fatty acids (column 5, lines 9-15);

(9) wherein the composition further comprises up to 20 wt% of at least one additive selected from the group consisting of terpenes, terpene alcohols, C₈-C₁₄ alcohol acetate ester blends, glycols, diacid esters, and petroleum hydrocarbons (column 5, lines 16-35, *particularly column 5, lines 32-35*);

(10) further comprising up to 10 wt% of a surfactant (column 5, lines 36-40); (11) wherein the surfactant is selected from the group of ethoxylated nonylphenols, linear alcohol ethoxylates, and alkanolamine salts of dodecylbenzene sulfonic acid (column 5, lines 36-40); and

(12) wherein the fatty acid alkyl ester blend is present in amounts of about 50 to 95 wt% (column 4, lines 10-24).

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 3, 4, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howe (US Pat. No. 5,494,611).

Regarding claims 1, 3, 4, and 9-12, Howe discloses: (1) a composition comprising: a fatty acid alkyl ester blend (Abstract; column 2, lines 5-40; column 3, lines 3-8 and 25-58) and about 1 to 20 wt% of at least one lower alkyl glycol ether selected from methyl, ethyl, propyl or

Art Unit: 1796

butyl ethers of ethylene glycol, diethylene glycol, dipropylene glycol or tripropylene glycol and mixtures thereof (Abstract; column 4, line 65 through column 5, lines 29); wherein the fatty acid alkyl ester blend contains C₁-C₄ esters of C₄-C₂₂ fatty acids (column 3, lines 25-68);

(3) wherein the fatty acid alkyl ester blend contains esters selected from the group consisting of methyl, ethyl, n-propyl, isopropyl, and n-butyl esters of C₄ to C₂₂ fatty acids (column 3, lines 25-68); (4) wherein the fatty acid alkyl ester blend contains esters selected from the group consisting of the methyl esters of C₄ to C₂₂ fatty acids (column 3, lines 25-68);

(9) wherein the composition further comprises up to 20 wt% of at least one additive selected from the group consisting of terpenes, terpene alcohols, C₈-C₁₄ alcohol acetate ester blends, glycols, diacid esters, and petroleum hydrocarbons (Abstract; column 2, lines 5-40; column 3, lines 3-24);

(10) further comprising up to 10 wt% of a surfactant (Abstract; column 2, lines 5-40; column 3, line 59 through column 4, line 64); and (11) wherein the surfactant is selected from the group of ethoxylated nonylphenols, linear alcohol ethoxylates, and alkanolamine salts of dodecylbenzene sulfonic acid (column 4, lines 48-64).

Howe fails to explicitly disclose: (1) wherein the fatty acid alkyl ester blend is present in amounts of about 40 to 99 wt%; and (12) wherein the fatty acid alkyl ester blend is present in amounts of about 50 to 95 wt%. Rather, he discloses, "The fatty acid alkyl esters are preferably used in amounts of about 2 to 8 weight percent. At amounts less than 2 weight percent removal of oily and greasy soils is less effective. At greater about 8 weight percent, either foaming is reduced and/or the solubilization of the component in the cleaning composition is more difficult and rinsibility is not good. *However, levels of fatty acid alkyl esters greater than 8 weight*

Art Unit: 1796

percent does increase tar and heavy grease removal," (column 3, lines 50-58). This disclosure demonstrates that the amount of fatty acid alkyl esters is recognized as a result effective variable. Specifically, higher amounts allow for increased tar and heavy grease removal.

In light of this, it has been found that, "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation," – *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); and "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation," – *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the instantly claimed amounts of fatty acid alkyl esters in the composition of Howe because he demonstrates that this concentration is a result effective variable. Amounts greater than 8 weight percent increases tar and heavy grease removal.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Principato (US Pat. No. 5,340,493) in view of Hendriksen et al. (US Pat. No. 5,693,600).

Regarding claim 13, Principato fails to explicitly disclose: **(13)** wherein the composition further comprises at least 1 wt% of an antioxidant.

Hendrickson et al. disclose an analogous composition to the one set forth in Principato (*see Abstract*). Furthermore, they disclose that minor amounts of antioxidants are recognized as

Art Unit: 1796

suitable additives for this type of composition. They are useful for their inherent antioxidant properties (*see column 5, lines 45-54*).

In light of this, it has been found that the selection of known material based on its suitability for its intended use supports a *prima facie* obviousness determination – *see MPEP 2144.07*.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add minor amounts of antioxidants, as taught by Hendriksen et al., in the composition of Principato because the teaching of Hendriksen et al. demonstrate that minor amounts of antioxidants are recognized as suitable additives for this type of composition.

Claim Objections

9. Claims 6-8 are objected to because of the following informalities: in the second formula of claim 6, “(C₃H₄O)” should be replaced with --(C₃H₆O)--. Claims 7 and 8 are objected to because they are dependent from claim 6. Appropriate correction is required.

Allowable Subject Matter

10. Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

Mulcahy et al. suggest the use of a second nonionic surfactant comprising heteric (poly)alkylene oxide condensation product of C₁₂-C₁₈ alcohol. However, they fail to suggest a lower alkyl termination, as claimed.

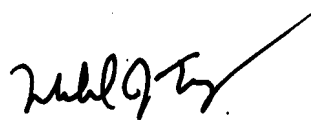
Art Unit: 1796

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael J. Feely
Primary Examiner
Art Unit 1796

October 29, 2007

**MICHAEL FEELY
PRIMARY EXAMINER**